

REMARKS

The rejections under 35 U.S.C. § 103(a) of:

Claims 1-2 and 9-19 over JP 5-42944 (Jiro et al) in view of U.S. 2001/0039320 (Jacobsen et al) and JP 7-276482 (Norio et al);

Claims 3-6 over Jiro et al in view of Jacobsen et al and Norio et al, and further in view of U.S. 5,254,302 (Yamanaka);

Claims 7-8 over Jiro et al in view of Jacobsen et al and Norio et al, and further in view of EP 0254923 (Dudley);

Claims 20-23 over Jiro et al in view of Jacobsen et al and Norio et al, and further in view of U.S. 2002/0148843 (Shen et al); and

Claim 24 over Jiro et al in view of Jacobsen et al and Norio et al, and further in view of U.S. 6,431,401 (Giblin et al),

are respectfully traversed.

The present invention relates to a labeled resin bottle, and, in particular, to a labeled resin bottle which affords an acceptable bottle strength even with reduced resin bottle thickness, and which provides a reduced amount of source resins therein to thereby provide reduced environmental impact.

As described under "Description of the Background" beginning at page 1, line 14 of the specification, resin bottles, noted for their relatively light weight and strength against drop impact have been widely used for various products, but these bottles are bulky after being emptied and present serious environmental problems. Efforts have been made for weight reducing and thinning of resin bottles to address these problems, but such thinning and weight reduction results in lowered buckling strength, which causes undesirable deformation of the bottles during filling of the contents, during transportation or storage in a stacked manner, or during use thereof. A need exists for a labeled resin bottle which can successful

withstand reduced bottle strength while reducing the base weight of the resin bottle to facilitate volume reduction at disposal. More specifically, a need exists for a labeled resin bottle unlikely to deform by virtue of large buckling strength during filling, transportation or storage in a stacked manner, or during use thereof. A need also exists for a labeled resin bottle which exhibits excellent handling to a level sufficient to replace the conventional self-standing pouch and which exhibits an appropriate buckling strength and drop impact strength.

The present invention successfully addresses these needs.

As recited in above-amended Claim 1, the present invention is a labeled resin bottle, comprising a resin bottle and one or more labels placed thereon and fused therewith, wherein said resin bottle has **(A) a value of $W/(V^{2/3})$ within a range from about 0.1 to 0.5**, wherein W is a base weight thereof, and V is a fill-in volume, thereof, provided that when the value is about 0.1 or larger and smaller than about 0.3, the bottle has a major thick layer consisting essentially of a polyolefinic resin having a stiffness of about 5,000 kgf/cm² or below, and wherein said **(B) label has a tensile elastic modulus of about 5,000 to 30,000 kgf/cm²**, wherein the resin bottle comprises a mouth/shoulder portion, a barrel portion and a bottom portion, and the **(C) thickness ratio of the barrel portion in respect to a minimum thickness of the mouth/shoulder portion and the bottom portion including a bottom corner portion is within a range of from about 0.1 to 0.9**. (Alphabetical prefixes and emphasis added.)

Applicants have shown that a combination of the above three characteristics (A)-(C) produces a result that could not have been predicted by the applied prior art, discussed in further detail below.

The specification contains comparative data between the presently-claimed invention, and corresponding bottles outside the terms of the present claims. Particularly pertinent herein are the data in Table 1, at page 16 of the specification, **attached herewith**. Examples

1-6 are according to the present invention. Comparative Examples 1-7 are not. The meaning under the sub-heading "Type" under the heading "Label", is described in the specification at page 11, line 8 through page 13, line 5. A review of the data in Table 1 demonstrates that only when all of above properties (A)-(C) are satisfied is the labeled bottle superior in all tested properties. For example, Comparative Examples 1 and 5 satisfy none of characteristics (A)-(C), and demonstrate a poor volume reducing property. Comparative Example 3, which satisfies characteristic (A) and (C) only, shows inferior buckling strength.

The above-discussed data could not have been predicted by the applied prior art, nor does the applied prior art render the presently-claimed invention *prima facie* obvious.

Jiro et al discloses a labeled squeezable container, wherein the label is made of a synthetic resin film and is integrally welded to the squeezable body part of the container, which label has a thickness of 50-100 μm , wherein the shrinkage factor of the label is lower than that of the container main body, the ratio between the thickness at an area on the squeezable body part on which the label is welded, and the thickness of an area on which the label is not welded, is in a range of 0.8 – 1.2. Jacobsen et al discloses a novel ethylene copolymer, and its use in a wide variety of applications including blow-molded articles, such as bottles and containers ([0338]). Norio et al discloses a flat bottle fitted with an in-mold label, wherein the value W/D of the ratio of the maximum width dimension W of the side surface of the body part having the narrower width and the minimum outer diameter dimension D of the neck part is set to 1.0 – 2.0, and a cutting-off part of which the upper end outer diameter dimension is smaller than the minimum outer diameter dimension of the neck part is provided to the upper part of the neck part and cut off and separated after the blow molding of the bottle.

It is not clear why one skilled in the art would combine Jiro et al and Norio et al, even if one skilled in the art were to use the ethylene copolymer of Jacobsen et al in either Jiro et

al's squeezable container or Norio et al's flat bottle. There appears to be no relation between Jiro et al and Norio et al except that they both relate to labeled bottles or containers.

Nevertheless, even if Jiro et al, Jacobsen et al and Norio et al were combined, the result would still not be the presently-claimed invention. None of these references addresses the above-discussed characteristics (A)-(C), let alone the demonstration in the comparative data of record that these characteristics are result-effective variables.

The Examiner relies on Jiro et al as teaching that the thickness of an overall container body can be varied and relies on Norio et al as teaching that the overall width of a bottle is variable. However, common sense suggests such variability. The Examiner states at page 6 of the Office Action: "Since the thickness of the container, the density of the container and the width of the container, all of which contribute substantially to applicant's claimed thickness [ratio], are all variable, one of ordinary skill in the art would have recognized that the thickness ratio recited in Claims 10-11 [now Claims 1 and 11] would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results."

In reply, the Examiner has not shown that the prior art was aware that any of the above characteristics (A)-(C), let alone the combination thereof, are result-effective variables. Thus, the present claims are patentable under the rationale of *In re Antonie*, 195 USPQ 6, 8-9 (CCPA 1977) (**copy enclosed**) (exceptions to rule that optimization of a result-effective variable is obvious, such as where the results of optimizing the variable are unexpectedly good or where the variable was not recognized to be result effective). Applicants are entitled to prevail under either of the above exceptions.

None of the other applied prior art, i.e., Yamanaka, Dudley, Shen et al, and Giblin et al, remedy the above-discussed deficiencies in the combination of Jiro et al, Jacobsen et al, and Norio et al.

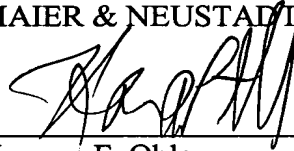
For all the above reasons, it is respectfully requested that the rejections over prior art be withdrawn.

The rejection of Claim 19 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

All of the presently pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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Table 1

	Bottle				Label		Assessment	
	Material	Bottle shape	$W/(V^{2/3})$	Thickness ratio of barrel portion	Type	Tensile elastic modulus (kgf/cm ²)	Buckling strength (kgf)	Volume reducing property
Example 1	material 1	Fig. 1	0.45	0.63	(1)	16,000	52.4	○
Example 2			0.45	0.63	(2)	24,000	57.5	○
Example 3			0.36	0.65	(1)	16,000	45.5	○
Example 4			0.37	0.42	(1)	16,000	50.1	○
Comparative Example 1			0.71	0.96	—	—	63.9	×
Comparative Example 2			0.45	0.63	—	—	34.4	○
Comparative Example 3			0.45	0.63	(3)	4,500	37.7	○
Comparative Example 4			0.37	0.42	—	—	31.5	○
Example 5	material 2	Fig. 2	0.40	0.61	(1)	16,000	35.2	○
Comparative Example 5			0.66	0.92	—	—	43.9	×
Comparative Example 6			0.40	0.61	—	—	29.8	○
Example 6	material 3	Fig. 3	0.32	0.78	(1)	16,000	38.9	○
Comparative Example 7			0.32	0.78	—	—	31.7	○

In re Antonie, 195 USPQ 6 (CCPA 1977)

In re Antonie

**(CCPA)
195 USPQ 6**

Decided Aug. 18, 1977

No. 76-681

U.S. Court of Customs and Patent Appeals

Headnotes

PATENTS

1. Patentability -- Invention -- In general (§ 51.501)

Court of Customs and Patent Appeals must first delineate invention as whole in determining whether invention as whole would have been obvious under 35 U.S.C. 103; it looks not only to subject matter that is literally recited in claim in question but also to those properties of subject matter that are inherent in subject matter and are disclosed in specification, in delineating invention as whole; just as chemical and its properties are looked to when obviousness of composition of matter claim is examined for obviousness, invention as whole, not some part of it, must be obvious under Section 103.

2. Patentability -- Invention -- In general (§ 51.501)

Controlling question in determining obviousness is simply whether differences between prior art and invention as whole are such that invention as whole would have been obvious.

3. Patentability -- Invention -- In general (§ 51.501)

Standard of 35 U.S.C. 103 is not that it would be obvious for one of ordinary skill in art to try invention; disregard for unobviousness of results of "obvious to try" experiments disregards "invention as a whole" concept of Section 103, and overemphasis on routine nature of data gathering required to arrive at applicant's discovery, after its existence became expected, overlooks last sentence of Section 103.

4. Patentability -- Change -- In general (§ 51.251)

Patentability -- Invention -- In general (§ 51.501)

Exception to rule that discovery of optimum value of variable in known process is normally obvious occurs when parameter optimized was not recognized to be result effective variable.

Particular patents -- Contactor Apparatus

Antonie, Rotating Biological Contactor Apparatus, rejection of claims 1-3 reversed.

Case History and Disposition:

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Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Ronald L. Antonie, Serial No. 331,796, filed Feb. 12, 1973. From decision rejecting claims 1-3, applicant appeals. Reversed; Miller, Judge, concurring in result; Maletz, Judge, with whom Rich, Judge, joins, dissenting with opinion.

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Attorneys:

Arthur H. Seidel, Thomas W. Ehrmann, and Quarles & Brady, all of Milwaukee, Wis., for appellant.

Joseph F. Nakamura (R. D. Edmonds, of counsel) for Commissioner of Patents and Trademarks.

Judge:

Before Markey, Chief Judge, Rich, Baldwin, and Miller, Associate Judges, and Herbert N. Maletz, * Associate Judge, United States Customs Court.

Opinion Text

Opinion By:

Baldwin, Judge.

This is an appeal from a decision of the Patent and Trademark Office (PTO) Board of Appeals (board) affirming the rejection of claims 1, 2 and 3 of an application for "Rotating Biological Contactor Apparatus" ¹ as obvious under 35 USC 103 in view of El-Naggar. ² We reverse.

The Invention

Appellant claims a wastewater treatment device in which wastewater is continuously passed through a tank. Semi-immersed contactors (disks) are continuously rotated to aerate their immersed portions and thereby to aerate both microorganisms that grow on the contactors and the wastewater itself. For this discussion, several variables are important in this device. "Throughput" is the volume of wastewater per unit time (gal./day) which the device must treat. "Contactor area" is the total area of the contactors which is exposed to the wastewater as the contactors are rotated (sq. ft.). "Tank volume" is the actual volume of liquid in the tanks in which the contactors rotate (gal.). The ratio of throughput to contactor area (gal./day/sq. ft.) is called the "hydraulic loading." Two concepts of effectiveness of the equipment are important in this discussion. The primary prior art reference uses the term "efficiency" to denote the percent impurity reduction which a given set-up of the device achieves and we shall so use the term. Appellant uses the term "maximum treatment capacity" to denote when a *unit of contactor area* is providing maximum "efficiency" for a given "throughput" or maximum "throughput" for a given "efficiency." It is essential to understand the distinction between "efficiency," a matter of ultimate effectiveness independent of the efficiency of the equipment, and "treatment capacity," a matter of the efficiency or effectiveness of a unit of contactor area. The latter is more properly associated with the normal use of the term "efficiency" denoting maximum result from a limited resource.

Appellant's claimed device has a ratio of tank volume to contactor area of 0.12 gal./sq. ft. ³ Appellant maintains that this ratio is the most desirable or optimum for all set-ups of the device in the sense that using a lower value gives lower "treatment capacity" and using a greater value gives no increase in "treatment capacity," merely increasing costs. Thus, the value is optimum in that it maximizes "treatment capacity" so that the effectiveness of a given contactor is maximized.

The Prior Art

El-Naggar teaches the basic structure of the device claimed by appellant but is silent regarding quantitative design parameters other than to give data on a single example, which data was apparently complete *except for any discussion of "tank volume."* El-Naggar stated the "efficiency" (obviously referring to the purity of the output) could be increased to 95% by increasing the area of the contactor.

The Rejection

The examiner rejected the claims as obvious under 35 USC 103, noting that the basic device in question is old as taught by El-Naggar. While the ratio of tank volume to contactor area of 0.12 gal./sq. ft. is not disclosed in El-Naggar, the examiner reasoned that the disclosure of El-Naggar would make a device with that optimum value obvious. The examiner noted that El-Naggar suggests increasing the "efficiency" (degree of purification) of his device by increasing the contactor area while apparently keeping the "throughput" constant, that is, reducing the "hydraulic loading." The examiner then *assumed* that El-Naggar teaches keeping the

tank volume constant while increasing the contactor area. Thus, the examiner argued that the idea of increasing tank volume to surface area to increase efficiency is taught and that working out the value for optimum efficiency is mere mechanical experimentation. The board accepted the examiner's reasoning.

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Opinion

[1] In determining whether the invention as a whole would have been obvious under 35 USC 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question (the ratio value) but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification. In *re Davies*, 475 F.2d 667, 177 USPQ 381 (CCPA 1973). In this case, the invention as a whole is the ratio value of 0.12 *and* its inherent and disclosed property. That property is that the described devices designed with the ratio will maximize treatment capacity regardless of the values of the other variables in the devices. Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention *as a whole*, and not some part of it, which must be obvious under 35 USC 103. Cf. In *re Papesch*, 50 CCPA 1276, 315 F.2d 381, 137 USPQ 43 (1963).

[2] The controlling question is simply whether the differences (namely the value of 0.12 and its property) between the prior art and appellant's invention as a whole are such that appellant's invention as a whole would have been obvious. The answer is no. It is impossible to recognize, from the experiment taught by El-Naggar, that "treatment capacity" is a function of "tank volume" or the tank volume-to-contactor area ratio. Recognition of this functionality is essential to the obviousness of conducting experiments to determine the value of the "tank volume" ratio which will maximize treatment capacity. Such functionality can *only be determined* from data representing either efficiency at varying tank volume, fixed throughput, and fixed contactor area or throughput at varying tank volume, fixed efficiency, and fixed contactor area. Each of these experiments represents treatment capacity with fixed contactor area but varying tank volume. This sort of experiment would not be suggested by the teachings of El-Naggar since he was not trying to maximize or control "treatment capacity." The experiments suggested by El-Naggar do not reveal the property which applicant has discovered, and the PTO has provided us with no other basis for the obviousness of the necessary experiments.

[3] The PTO and the minority appear to argue that it would always be *obvious* for one of ordinary skill in the art *to try* varying *every* parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. ⁴ As we have said many times, *obvious to try* is not the standard of 35 USC 103. In *re Tomlinson*, 53 CCPA 1421, 363 F.2d 928, 150 USPQ 623 (1966). Disregard for the unobviousness of the results of "obvious to try" experiments disregards the "invention as a whole" concept of §103. In *re Dien*, 54 CCPA 1027, 371 F.2d 886, 152 USPQ 550 (1967) and In *re Wiggins*, 55 CCPA 1356, 397 F.2d 356, 158 USPQ 199 (1968), and overemphasis on the routine nature of the data gathering required to arrive at appellant's discovery, after its existence became expected, overlooks the last sentence of §103. In *re Saether*, 492 F.2d 849, 181 USPQ 36 (CCPA 1974).

[4]In *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1955), the court set out the rule that the discovery of an optimum value of a variable in a known process is normally obvious. We have found exceptions to this rule in cases where the results of optimizing a variable, which was known to be result effective, were unexpectedly good. In

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re *Waymouth*, 499 F.2d 1273, 182 USPQ 290 (CCPA 1974); In *re Saether*, *supra*. This case, in which the parameter optimized was not recognized to be a result-effective variable, is another exception. The decision of the board is reversed.

Footnotes

Footnote 1.

Serial No. 331,796, filed February 12, 1973.

Footnote 2. "Method of Treatment of Sewage by Bio-Oxidation and Apparatus Therefor," U.S. Patent No. 3,335,081, issued August 8, 1967.

Footnote 3. Claims 1 and 2 recite "at least about 0.12" while claim 3 recites "about 0.12."

Footnote 4. The precise nature of the El-Naggar experiment and the nature of the data which would result are rendered hopelessly speculative by El-Naggar's total failure to discuss the critical matter of what is done with the volume of the tank. The PTO appears to assume, as a necessary element of its conclusion, that appellant's ratio is the inevitable result of El-Naggar experiment, and that the tank volume is fixed, apparently because El-Naggar does not suggest changing the tank as additional contactor area is supplied. Even if the same tank were used, the actual liquid volume of the tank could change significantly if 1) the tank has a level control, 2) the tank is not extremely large in comparison to the contactors and 3) the volume-to-area ratio of the contactors themselves is significant. Since these assumptions are not unreasonable, there is serious doubt as to the constant volume of the tank.

Whether one would inevitably arrive at the ratio value of 0.12 or above depends on facts which must be read into El-Naggar, (e.g., the volume of the tank) and on assumptions about the kind of motivation (e.g., the degree of "efficiency" which would be sought). All of this involves, at least on this record, mere speculation. Assuming, as the examiner has, that the tank volume is fixed and the natural motivation is to maximize efficiency, if El-Naggar's equipment has a tank volume to contactor area ratio of less than 0.12, and the resulting efficiency is found wanting, increasing the contactor area to increase "efficiency" will lead away from the claimed ratio.

Dissenting Opinion Text

Dissent By:

Maletz, Judge, with whom Rich, Judge, joins, dissenting.

With all due respect, I cannot agree with the majority's interpretation of the El-Naggar patent.

El-Naggar discloses the same wastewater treatment apparatus as claimed, except for the specific volume-to-surface ratio of .12 gallons per square foot as recited in the claims. However, El-Naggar generally discloses varying the number of disks (column 3, lines 31-35), the number of concentric cylinders (column 4, lines 27-30), or the length of the cylinders (column 4, lines 61-62) in his apparatus in order to optimize results. Given the basic apparatus of El-Naggar and the concept of varying the number of disks in a tank in order to optimize impurity removal, I believe that it would have been well within the capabilities of the chemical engineer of ordinary skill to determine empirically, by routine experimentation, the optimum design ratio which appellant has determined and recited in his claims. That is, El-Naggar set the way, and appellant's work was what any routineer would have accomplished in following the patent teachings.

Appellant urges that the results which he determined empirically by plotting the effect of volume-to-surface ratio on impurity removal, including the specific, optimum design ratio of .12 gallons per square foot, could not have been predicted from El-Naggar. However, obviousness under 35 USC 103 does not require absolute predictability, *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976), and it is sufficient here that El-Naggar clearly led the way for the routineer to arrive at the claimed apparatus.

I am in substantial agreement with the board's analysis of this case, and I would affirm the board's decision.

Footnote * Judge of the United States Customs Court sitting by designation pursuant to 28 U.S.C. 293(d).

- End of Case -